

REMARKS

Claims 17-20, 51, and 52 currently are pending in this application. Claims 18-20 are canceled in the present reply. Claims 17, 51 and 52 are currently amended. These claims have been canceled or amended without prejudice to, or disclaimer of, the subject matter thereof. Applicant reserves the right to file continuing applications directed to the subject matter of any claim canceled or amended for any reason.

The amendments to claims 17, 51 and 52 place the application in better condition for examination. It is submitted that no new matter has been introduced by these amendments with support found throughout the specification as filed. By these amendments, Applicant does not acquiesce to the propriety of the Office's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 USPQ.2d 1865 (US 1997).

I. 35 U.S.C. § 103 Rejections

Claims 17-20, 51 and 52 stand rejected under 35 USC § 103(a) as allegedly unpatentable over US Patent No. 6,548,068 ("Schlom") and Dranoff *et al.*, 1993, Proc. Natl. Acad. Sci. USA 90: 3539-3543 ("Dranoff"). April 2, 2009 Office Action ("OA"), page 3. Applicant respectfully disagrees with these rejections and the Office's positions regarding the same.

To maintain a proper rejection under 35 U.S.C. § 103, the Office must meet four conditions to establish a *prima facie* case of obviousness. First, the Office must show that the prior art suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process. Second, the Office must show that the prior art would have provided one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in an applicant's disclosure. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Fourth, if an obviousness rejection is based on some combination of prior art references, the Office must show a suggestion, teaching, or motivation to combine the prior art references ("the TSM test").

In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Following *KSR Int'l Co. v. Teleflex, Inc.*, this fourth prong of the *prima facie* obviousness analysis must not be applied in a rigid or formulaic way such that it becomes inconsistent with the more flexible approach of *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966); 127 S. Ct. 1727 (2007). It must still be applied, however, as the TSM test captures the important insight that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at 1741 (citing *United States v. Adams*, 383 U.S. 39, 50-52 (1966)).

As pending, the claims recite primary tumor cells modified to express immune modulators consisting essentially of B7-2 and GM-CSF. Support for this amendment can be found at, for example, Examples 1, 2, 4, 5 and 9. Schlom discloses the inclusion of IL-1, ICAM-1, LFA-3, CD72, TNF α , IFN γ , IL-12, IL-6 and combinations thereof, immune modulators excluded from the present claims. Accordingly, Schlom does not teach or suggest primary tumor cells modified to express the particular combination of B7-2 and GM-CSF and, as a result, does not teach or suggest all the claim limitations. Dranoff does not remedy this deficiency of Schlom.

Based on the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the pending rejections of claims 17, 51 and 52 under 35 U.S.C. §103.

CONCLUSION

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue and therefore Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-3207.

Respectfully submitted,

Dated: September 1, 2009

/C. Rachal Winger/
C. Rachal Winger, Ph.D.
Registration No. 55,815
CUSTOMER NUMBER: 45,200

K&L GATES LLP
1900 Main Street, Suite 600
Irvine, California 92614-7319
Telephone: (949) 253-0900
Facsimile: (949) 253-0902